

REMARKS

Restriction Requirement:

A brief history of the subject application has been provided in the response to the previous Office action. In summary, the Examiner in a previous Office action had imposed a restriction requirement under 35 U.S.C. 121. In the response to the restriction requirement, the Applicants provisionally elected species 4 with traverse.

The Examiner currently states that the Applicants' arguments in support of the traverse are not persuasive and that the restriction requirement is deemed proper and final. The Examiner also currently states that none of the claims are generic. The Examiner has indicated in the current Office action that claims 1-8, 10-16, 21, and 22 are pending.

The Applicants maintain that the restriction requirement was not proper, and further contend that claim 1, in its previous form (before the current amendments thereto shown herein above) was, and is currently, generic because it was an independent claim from which all other claims depend.

Furthermore, the Applicants contend that the restriction requirement is now moot in view of the amendments to the claims, which are described below.

Amendments to the Claims:

Claim 1 has been amended by incorporating at least a portion of the elements and/or limitations of claim 5. Accordingly, claim 5 has been canceled in view of the amendments to claim 1. Claims 2-4, and 11 have also been canceled.

Claim 10 has been amended to change the dependency of that claim from claim 5 to claim 1, in view of the cancellation of claim 5, and to change some of the terminology of that claim in order to be consistent with the amendments to claim 1.

New claims 23-27 have been added. No new matter has been added.

Rejection of Claims Under 35 U.S.C. 112:

In the current Office action, the Examiner has rejected claims 1-8, 10-16, and 21-22 under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement. The Examiner contends that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the

1 art to which it pertains, or with which it is most nearly connected, to make and/or use
2 the invention. Specifically, the Examiner states,

3 *"Claim 1 recites a guide (reference number 134) that substantially
4 constrains movement of the objects (110, 120) longitudinally along
5 paths 131, 132. As noted in the Office action dated 6/29/04, the
6 elected species 4 can not be operated with such guides. See figures
7 11-13. The elected species 4 is incompatible with claim 1 and
8 incompatible with the guides disclosed in the specifications and
9 drawings. In response to the Office action dated 6/29/04, Applicant
10 argues that the guides can act to align the objects as shown in figure
11 13. The Examiner is not persuaded. First, nowhere in the
12 specification or in any drawing is there any suggestion that the
13 assembly as shown in figure 13 alone, disregarding figures 11, 12, and
14 14-16, might be used in combination with the guides shown in figure 4.
15 Nowhere in the originally filed specification and drawings is there any
16 suggestion that the invention might be reconfigured as suggested in
17 the Applicants' arguments. A person with ordinary skill in the art would
18 have no basis whatsoever for taking the configuration of figure 13
19 completely out of context of the specification and drawings and
20 somehow applying it to the configuration shown in figure 4, rendering
21 the remaining figures 11, 12, and 14-16 completely inapplicable.
22 Furthermore, cam surface 181 would serve no purpose if the invention
23 was to be rearranged as suggested."*

24 As noted by the Examiner, the requirement under 35 U.S.C. 112, first
25 paragraph is also known as "the enablement requirement." The Applicants note that
the enablement requirement is explained with relative detail in section 2164 of
the MPEP.

26 Specifically, "[a]ny analysis of whether a particular claim is supported by the
27 disclosure in an application requires a determination of whether that disclosure,
28 when filed, contained sufficient information regarding the subject matter of the claims
29 as to enable one skilled in the pertinent art to make and use the claimed invention."
(MPEP, section 2164.01.)

1 Moreover, “[t]he standard for determining whether the specification meets the
2 enablement requirement was cast in the Supreme Court decision of *Mineral*
3 *Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the
4 experimentation needed to practice the invention undue or unreasonable?” (Id.) In
5 other words, “[t]he test of enablement is whether one reasonably skilled in the art
6 could make or use the invention from the disclosures in the patent coupled with
information known in the art without undue experimentation.” (Id.)

7 As indicated herein above, the Applicants have amended claim 1. The
8 Applicants contend that the amendments to claim 1 overcome the Examiner’s
9 rejection under 35 U.S.C. 112, first paragraph. Accordingly the Applicants
10 respectfully request that the rejection of claim 1 be withdrawn and that the claim
be allowed.

11 Notwithstanding the current amendments to claim 1, the Applicants
12 respectfully disagree with the Examiner’s contention that claims 1-8, 10-16, and 21-
13 22 (in the previous Office action) failed to comply with the enablement requirement.
14 That is, the Applicants contend that claims 1-8, 10-16, and 21-22 met the
15 enablement requirement before the current amendments thereto because the
16 specification contains sufficient information regarding the subject matter of the
17 claims as to enable one skilled in the pertinent art to make and use the claimed
18 invention, and that one reasonably skilled in the art could make or use the invention
from the disclosures coupled with information known in the art without undue and/or
unreasonable experimentation.

19 The Applicants note that claim 1 was written (before the current amendment)
20 as follows:

21 *Claim 1. An apparatus for electrically connecting two objects together, comprising:*
22 *a first object which has a first connective surface defined thereon;*
23 *a row of first electrical contacts supported on the first connective surface;*
24 *a second object which has a second connective surface defined thereon;*
25 *a row of second electrical contacts supported on the second connective
surface and configured to contact the first electrical contacts; and,*
 *a guide that allows the first and second objects to be placed adjacent to one
another in facilitation of electrical connection therebetween by substantially
constraining movement of the first object relative to the second object to a given*

1 direction and along a continuous path of movement which is substantially parallel to
2 the row of first electrical contacts.

3 The Applicants note that all of the elements and/or limitations of claim 1 are
4 exhaustively described in the Applicants' disclosure. For example, both the first
5 object (110) and the second object (120) are shown in each of figures 3-14, and
6 17-18, as well as being discussed and/or mentioned at least once on each of pages
7 4-20 of the written specification. That is, the first object (110) and the second object
8 (120) are shown in at least thirteen (13) of the Applicants' figures, along with being
9 discussed on each of at least sixteen (16) pages of the Applicants' written
10 description.

11 The Applicants note with particularity that, the Applicants' specification reads
12 as follows: "*although the first and second objects 110, 120 are otherwise depicted
13 herein [in the application] to be configured as 'rectangular boxes,' each object 110,
14 120 can be configured in any shape which allows the first electrical pads [contacts]
15 112 to be presented to the second electrical pads [contacts] 122 such that contact
16 between the first and second electrical pads 112, 122 can be accomplished by the
17 manner described herein.*" (Applicants' specification at page 9, line 33 through page
18 10, line 3.)

19 The Applicants further note that the guide (134) is shown in the Applicants'
20 figures 4, 5, and 7, and that the guide is described as being "configured to guide the
21 first and second objects 110, 120 . . . along the first and second paths of movement
22 131, 132 respectively. The guides 134 can also serve to provide a given alignment
23 of the first and second objects 110, 120 relative to one another . . ." (Applicants'
24 specification at page 9, lines 1-5.)

25 In regard to claim 1, the Applicants contend, in view of the foregoing
26 discussion, that the Applicants' disclosure contains more than sufficient information
27 regarding the subject matter of claim 1 as to enable one skilled in the pertinent art to
28 make and use the claimed invention, and that one reasonably skilled in the art could
29 make or use the invention from the disclosures coupled with information known in
30 the art without undue and/or unreasonable experimentation.

31 Furthermore, the Applicants are not aware of any requirement that all the
32 elements of a given claim are to be depicted in a single drawing figure, which is what

1 the Examiner appears to be implying. The Applicants request that the Examiner cite
2 such a requirement if he is aware of it.

3 For at least the reasons set forth above, the Applicants contend that claim 1
4 in its previous form (before the current amendment) met, and currently meets (with
current amendments thereto), the enablement requirement.

5 Moreover, in regard to the Examiner's statements that, "the elected species 4
6 can not be operated with [the] guides [134]," and that the "elected species 4 is
7 incompatible with claim 1 and incompatible with the guides disclosed in the
specifications and drawings," the Applicants respectfully disagree.

8 The Examiner states further that, "nowhere in the specification or in any
9 drawing is there any suggestion that the assembly as shown in figure 13 alone . . .
10 might be used in combination with the guides shown in figure 4." (Office action,
page 4.) The Applicants respectfully disagree with this statement as well.

12 Firstly, the Examiner has provided no reasoning and/or evidence as to: 1)
why the elected species 4 cannot be used with the guides; and, 2) why the elected
13 species 4 is incompatible with claim 1 and incompatible with the guides. That is, the
14 Applicants do not understand the basis for the Examiner's above statements. As the
15 Applicants have stated above, they are not aware of any requirement that every
element of a given claim be depicted in a single drawing figure. All of the elements
16 of claim 1 in its previous form (before the current amendment) are shown in the
drawing figures.

18 Secondly, as is also explained above, the Applicants' specification and
19 drawings describe *exactly* how the guides (134) function and relate to the objects
(110) (120). Again, the Applicants note that the Applicants' figures 4, 5, and 7, along
21 with the related portions of written description, clearly describe the function and
configuration of the guide (134), the first object (110), and the second object (120),
as well as the relationship between the guide and the first and second objects. (See
23 Applicants' specification at page 6, line 4 through page 10, line 19.)

24 The Applicants note further that the Applicants' figures 11-18, along with the
25 related portions of written description, clearly describe the first and second objects
(110) (120) in accordance with one embodiment of the present disclosure. (See
Applicants' specification at page 13, line 1, through page 21, line 6.) That is,
although the Applicants' figures 11-18 depict the first and second objects (110) (120)

1 in greater detail than they are depicted in figures 4, 5, and 7, there is substantially no
2 difference with respect to the relationship between the guide (134) and the objects,
3 and the Applicants fail to see how such a difference can be inferred.

4 Stated another way, in accordance with one embodiment of the disclosure,
5 the first and second objects, as depicted in figures 11-18, incorporate the ridge (151)
6 and trough (161), respectively, as well as the alignment members (171) (172) and
7 related elements, none of which are depicted in figures 4, 5, and 7. However, it
8 would be clear to one skilled in the art from a study of the Applicants' disclosure that
9 the ridge, trough, alignment members, and related elements do not affect the
relationship between the guide and the first and second objects as described with
respect to figures 4, 5, and 7.

10 That is, a person skilled in the art could study the Applicants' disclosure and
11 could thereby understand that figure 13 (and other figures) simply depicts a more
12 detailed view of the first and second objects in accordance with one embodiment of
13 the disclosure as compared to the depiction of the first and second objects in figures
14 4, 5, and 7. Such a person skilled in the art would clearly understand from studying
15 the Applicants' disclosure that the first and second objects, as shown in figure 13
16 (and other figures), could be used with the guide as shown in figure 4 (and
other figures).

17 Accordingly, the Applicants contend that the Applicants' disclosure clearly
18 enables one skilled in the art to understand that the objects (110) (120), as depicted
19 in figures 11-18, can be used with the guides (134), which are depicted in figures 4,
20 5, and 7. Furthermore, one skilled in the art would clearly understand from the
21 Applicants' disclosure that the elected species 4 is compatible with claim 1 in its
previous form before the current amendments thereto.

22 The Examiner further states that, "the cam surface (181) would serve no
23 purpose if the invention was to be rearranged as suggested." (Office action at page
24 4.) The Applicants assume that by this statement the Examiner is contending that
25 the cam surface (181) serves no purpose when the guide (134) is used with the first
object (110) and the second object (120).

In response, the Applicants contend that the question of whether the cam
surface (181) serves any particular purpose is irrelevant to the issue of whether the

1 claim 1 meets the enablement requirement for at least the reason that claim 1 does
2 not recite the cam surface (181).

3 Notwithstanding this issue raised by the Examiner, the Applicants note that a
4 person skilled in the art could understand from a study of the Applicants' disclosure
5 that if the guide (134) is employed with the first object and the second object, the
6 cam surface (181) can be useful to more precisely align the first object relative to the
7 second object, wherein such alignment might be necessary as the result of
8 manufacturing tolerances (slop or slack in the guides), or the like. (See Applicants'
9 specification at page 17, line 1, through page 18, line 14.)

10 For at least the reasons set forth above, the Applicants contend that claim 1
11 in its previous form (before the current amendments thereto), as well as all other
12 claims, meet the enablement requirement as set forth by 35 U.S.C. 112, first
13 paragraph.

14 In regard to claims 2-8, 10-16, 21, and 22, the Examiner has not specifically
15 addressed any of those claims. Claims 2-5, and 11 have been canceled and the
16 rejections of those claims is therefore moot. The Applicants contend that each of
17 claims 6-8, 10, 12-16, 21, and 22 previously met and currently meet the enablement
18 requirement for the general reasons set forth above with respect to claim 1. That is,
19 in regard to each of claims 6-8, 10, 12-16, 21, and 22, each of the elements recited
in each of those claims is exhaustively described in the Applicants' disclosure.
Furthermore, such description in the Applicants' disclosure contains sufficient
information regarding the subject matter of each of those claims as to enable one
skilled in the pertinent art to make and use the claimed invention.

20 For at least these reasons, the Applicants contend that each of claims 6-8,
21 10, 12-16, 21, and 22 have met and currently meet the enablement requirement as
22 set forth by 35 U.S.C. 112, first paragraph. Accordingly, the Applicants respectfully
request that the rejections of claims 6-8, 10, 12-16, 21, and 22 be withdrawn and
that those claims be allowed.

24
25 New Claims:

New claims 23-27 have been added as shown herein above. All of the
elements and/or limitations of the new claims 23-27 have been substantially
contained in previous claims now canceled. Furthermore, the new claims 23-27 are

1 fully supported in the specification including the drawing figures. No new matter has
2 been added.

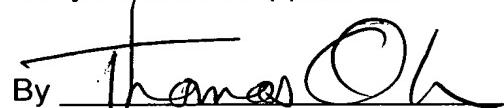
3 Request for Extension of Time:

4 The Applicants herewith petition the Commissioner of Patents and
5 Trademarks to extend the time for reply to the Office action dated 08/26/2004 for
6 one (1) month from 11/26/2004 to 12/26/2004. Please charge the Assignee's
7 deposit account in the amount to cover the cost of the extension as set forth in detail
on the attached Transmittal Letter.
8

9 **SUMMARY**

10 The Applicants believe this communication constitutes a full and complete
11 response to the Office action mailed 08/26/2004. The Applicants further believe that
12 claims 1, 6-8, 10, 12-16 and 21-27 are allowable, and therefore request timely
allowance of those claims.

13 The Examiner is respectfully requested to contact the below-signed attorney if
14 the Examiner believes this will facilitate prosecution toward allowance of the claims.
15

16 Respectfully submitted,
17 Thom Ives, Darrel Poulter, and
18 Andy Petersen, Applicants
19 By 

20 Thomas Olson
21 Attorney and agent for Applicant
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24
25

Date: December 24, 2004

Docket No. 10992566-4
Response to Office action
mailed on 08/26/2004